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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,189	03/26/1999	EDWARD G. MCLAUGHLIN	7196-RCE	3185

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EXAMINER
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POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3691

NOTIFICATION DATE	DELIVERY MODE
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07/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPAdmin@reinhardtllaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/277,189	<b>Applicant(s)</b> MCLAUGHLIN ET AL.	
	<b>Examiner</b> Frantzy Poinvil	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/18/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. The 35 USC 112, 2<sup>nd</sup> paragraph and 112, sixth paragraph have been withdrawn.
2. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling (US Patent No. 5,963,925) in view of Powar (US Patent No. 7,028,008).

As per claims 1 and 16, Kolling teaches a system and method for presenting an electronic bill or statement to a customer who has subscribed to receive electronic bills from a biller. See the abstract and column 12, lines 36-42. The system further comprises:

Allowing a customer to subscribe to a bill presentment system for receiving electronic-based bills (column 12, lines 36-42 and column 4, line 63 to column 5, line 16) of Kolling.

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notifying a plurality of billers that said customer has subscribed to said bill presentment system, said billers including electronic-based billers (column 4, line 63 to column 5, line 16 of Kolling);

receiving by the bill center one of an electronic bill and a paper bill for the customer from at least one of the billers regardless of the format for said customer from at least one of said billers (column 7, lines 25-57 of Kolling);

identifying the type of bill (is done using a template library. Also, different billers would send different bills and different types of bills for different customers) column 8, lines 52-62 and column 9, lines 28-64 of Kolling) ;

extracting billing information from said electronic image information wherein the billing information is extracted using a predefined template (see column 9, line 28 to column 10, line 21 and column 11, lines 43-55 of Kolling);

presenting said at least one electronic bill to said customer (column 13, lines 334-59 of Kolling).

Kolling further teaches establishing a bill center configured to receive all types of electronic bills from billers of the customer wherein the bill center is the sole source of electronically presenting the customer bills to the customer. See the abstract and column 8, lines 39-61.

Kolling does not specifically teach receiving paper bills for conversion to electronic bills. Thus, Kolling does not specifically teach the steps of:

receiving at least one paper bill for said customer from at least one of said billers;  
identifying the contents of said paper bill;

scanning said at least one paper bill received for said customer to generate electronic image information; and validating the extracted billing information generated from said scanned paper bill.

As per these limitations the Examiner notes that transmitting or mailing paper bills to Kolling for further processing and presenting to a customer in an electronic format would have been obvious to one of ordinary skill in the art to do at the time of the invention. Nothing in Kolling prevents Kolling from accepting paper bills for conversion to electronic formats. A biller in the system of Kolling may not have the capability to electronically transmit electronic bills to the system of Kolling for further processing by Kolling. Thus, transmitting paper bills to the system of Kolling would have been readily acceptable through the regular mail system.

In so doing, Kolling would have scanned the received paper bills, do further image processing and cleaning the scanned paper bills which would have then converted in an electronic format. The extracted steps would have also been done for indexing and record keeping purposes.

These steps are well known in the art of image processing and analysis of scanned financial documents. Since Kolling deals with electronic statements which are financial documents, one of ordinary skill in the art would have turned to the teachings of Powar for these teachings.

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Powar discloses a system and method for scanning a financial document such as a bill from a biller so that billing data is extracted from the bill. Image manipulation, data extraction and indexing are performed. See column 5, line 50 to column 6, line 17 of Powar. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Powar into the system and method of Powar in order to facilitate the conversion of paper bills into an electronic format for presenting to a customer. The motivation would have been to encourage billers who are not yet ready to transmit electronic bills to the bill processors of Kolling to do so, and also to facilitate the processing and/or conversion of paper bills to electronic bills format.

As per claims 2 and 17 removing unnecessary material from the received paper bill is taught by Powar as Powar teaches error-correction techniques and as read data is compared to previously collected general data. See column 6, lines 6-17 of Powar. Kolling further teaches forwarding important documents from the received bill to the customer (see the abstract and column 4, lines 15-29); receiving a payment instruction from the customer to pay a bill, drafting a payment on an account for the customer account, and sending the payment to the biller that originated the bill (are taught on column 9, lines 13-28 of Kolling).

As per claims 3 and 18, the combination of Kolling and Powar does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Powar would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claims 4 and 19, printing a stored scanned image of a remittance stub is not explicitly taught by Kolling. Powar discloses storing a scanned image of a remittance stub. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Powar into Kolling in order to store a scanned image of a remittance stub for record keeping, reconciliation and management of the combined financial system.

As per claims 5-6 and 20-21, the combined teaching of Kolling and Powar discloses drafting a payment comprising the step of submitting an electronic payment (see column 9, lines 14-48 of Kolling and the abstract of Powar) using one of an automated clearing house network, an automated teller machine network, and a credit card network

As per claims 7 and 22, the combined teachings of Kolling and Powar are discussed above. Powar et al disclose extracting billing information from the electronic image using optical character recognition wherein the billing information is extracted using a predefined template for the type of bill identified and extracting an image of the payment remittance stub. See column 5, line 50 to column 6, line 17 of Powar. Kolling also discloses a plurality of templates for customers' bills. Note column 10, line 49 to column 10, line 21 of Kolling.

As per claims 8 and 23, presenting an electronic image of a paper bill upon receipt of a request from the customer is taught by Kolling. See the abstract of Kolling.

Claim 9 contains features addressed in claim 1. Claim 9 is therefore rejected under a similar rationale as applied to claim 1 above.

As per claim 10, Kolling discloses a biller identification for identifying a particular bill. See column 10, lines 48-65 and column 9, lines 40-45 of Kolling.

As per claim 11, the combination of Kolling and Powar does not explicitly teach drafting a payment comprises the step of printing a physical check on the account. The Examiner notes that such is well known in the art the time of the filing of the invention. Incorporating such a feature in the combination of Kolling and Powar would have been obvious to one of ordinary skill in the art do in order to provide alternate forms of payment in the combined system.

As per claim 12, printing a stored scanned image of a remittance stub is not explicitly taught by Kolling. Powar teaches storing a scanned image of a remittance stub. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Powar into Kolling in order to store a scanned image of a remittance stub for record keeping, reconciliation and management of the combined financial system.

Claim 13 contains features recited in independent claims 1, 4, 5, 7 and 8, and therefore, applicant is directed to the rejection of claims 1,4, 5, 7 and 8 above.

As per claim 14, see column 5, line 50 to column 6, line 17 of Powar.

As per claim 15, see column 5, line 50 to column 6, line 17 of Powar.



***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/ Frantzy Poinvil /  
Primary Examiner  
Art Unit 3691**

July 18, 2010